



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,428	09/15/1999	JOHN S. HENDRICKS	SEDN/5915	7433
56015 7590 07/02/2007 PATTERSON & SHERIDAN, LLP/ SEDNA PATENT SERVICES, LLC 595 SHREWSBURY AVENUE SUITE 100 SHREWSBURY, NJ 07702			EXAMINER LONSBERRY, HUNTER B	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 07/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/396,428
Filing Date: September 15, 1999
Appellant(s): HENDRICKS ET AL.

MAILED

JUL 2 2007

Technology Center 2600

Eamon J. Wall
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/28/07 appealing from the Office action mailed 7/3/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The Examiner has withdrawn the 35 U.S.C. 112, first paragraph rejection of claims 1, 11, 23, 31, and 41.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,583,560 A	FLORIN	12-1996
US 5,483,277 A	GRANGER	1-1996
US 5,192,999 A	GRACZYK	3-1993
US 5,638,426 A	LEWIS	6-1997
US 5,247,575 A	SPRAGUE	9-1993
US 5,432,542 A	THILBADEAU	7-1995
US 4,920,339 A	FRIEND	4-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 3, 4, 6-13, 16-36, 38-44, and 47-55 are rejected under 35 U.S.C.

103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin in view of U.S.

Patent 5,483,277 to Granger and U.S. Patent 5,192,999 to Graczyk.

Regarding claim 1, Florin discloses in figures 1 and 2 a transceiver 54 for use with a television program delivery system with menu selection of programs (figure 12), the set top terminal having a microprocessor 63 and microprocessor instructions for prompting generation of menus (column 9, line 59-column 10, line 6), comprising:

An interface 82 to the STB for communicating data and video signals between the STB and a disc storage device (column 10, lines 7-19, a CD ROM module may playback multimedia CD ROM titles, photo CDs and motion picture CDs), A disc storage device 70 (or optional hard drive, column 10, lines 7-26) connected to the interface providing local storage capacity,

And a microprocessor 63 connected between the interface and the disc storage device (figure 2).

Florin discloses the use of a number of plug in devices such as hard discs, modems, and CD-ROMs (column 10, lines 7-26), but is silent regarding the use of a hardware upgrade and the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Granger discloses in figure 6, an upgrade module 300 for a set top box 302 which enables a user to operate more than two channels simultaneously (column 7, lines 11-41) thus enabling a user to expand the capabilities of a STB in the future.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Florin to utilize a hardware upgrade as taught by Granger thus enabling a user to expand the capabilities of a STB in the future.

The combination of Florin and Granger is silent regarding the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Graczyk discloses in figures 44-49, the use of a number of upgrade cards, including an audio upgrade card 510, which utilizes a microprocessor 33 (figure 28), which communicates with the CPU of the personal computer via interface 300, and includes an upgrade of an external CDROM, the personal computer includes STB functionality via the use of an onboard TV tuner (column 21, lines 19-59, column 22, lines 7-51, column 32, line 67-column 33, line 20, , lines 31-52, column 34, lines 3-6, 50-56), thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin and Granger to use a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface as taught by Graczyk, thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Regarding claim 2, Florin discloses that CDROM module 70 may play back an reference such as multimedia CD ROM titles (column 10, lines 8-13).

Regarding claim 4, Florin discloses that CDROM 70 is coupled to CPU 63, applications on CDROM 70 may be accessed by transceiver 54 (column 10, lines 7-19).

Regarding claims 6-8, Florin discloses that transceiver 54 may connect to external devices through a serial port or SCSI interface (column 10, lines 21-26).

Regarding claims 9-10, Florin discloses that the disc storage device may be a CD-ROM device (column 10, lines 7-19).

Regarding claim 11, Florin discloses in figures 1 and 2 a transceiver 54 for use with a television program delivery system with menu selection of programs (figure 12), the set top terminal having a microprocessor 63 and microprocessor instructions for prompting generation of menus (column 9, line 59-column 10, line 6), comprising:

A receiver 54 adapted to receive programs

An interface 64 to the STB for communicating data and video signals between the STB and a disc storage device (column 10, lines 7-19, a CD ROM module may playback multimedia CD ROM titles, photo CDs and motion picture CDs), A disc storage device 70 (or optional hard drive, column 10, lines 7-26) connected to the interface providing local storage capacity,

And a microprocessor 63 connected between the interface and the disc storage device (figure 2).

Florin discloses the use of a number of plug in devices such as hard discs, modems, and CD-ROMs (column 10, lines 7-26), but is silent regarding the use of a hardware upgrade or the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface .

Granger discloses in figure 6, an upgrade module 300 for a set top box 302 which enables a user to operate more than two channels simultaneously (column 7, lines 11-41) thus enabling a user to expand the capabilities of a STB in the future.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Florin to utilize a hardware upgrade as taught by Granger thus enabling a user to expand the capabilities of a STB in the future.

The combination of Florin and Granger is silent regarding the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Graczyk discloses in figures 44-49, the use of a number of upgrade cards, including an audio upgrade card 510, which utilizes a microprocessor 33 (figure 28), which communicates with the CPU of the personal computer via interface 300, and includes an upgrade of an external CDROM, the personal computer includes STB functionality via the use of an onboard TV tuner (column 21, lines 19-59, column 22, lines 7-51, column 32, line 67-column 33, line 20, , lines 31-52, column 34, lines 3-6, 50-56), thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin and Granger to use a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface as taught by Graczyk, thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Regarding claim 12, Florin discloses in Figure 36, a menu function in which the currently viewed AV source icon is automatically highlighted (column 21, lines 41-67).

Regarding claim 13, Florin discloses that transceiver 54 may connect to external devices through a serial port or SCSI interface (column 10, lines 21-26).

Granger discloses that a plugin expansion device connects to a STB in figures 6-7 (column 7, lines 11-41).

The combination of Florin and Granger fails to disclose the use of an expansion card slot and expansion card connector.

Graczyk is relied upon to teach the use of an expansion card slot 540 with connectors (figure 45), an upgrade card 510 (figure 44) fits into expansion card slot 540 via a connector.

Regarding claim 16, Florin discloses that one or more additional devices may be connected to the terminal (column 10, lines 21-26, figure 36).

Regarding claim 19, Florin discloses that the A/V connect module 66 may output for display signals from multiple connected devices simultaneously (column 9, lines 3-9).

Regarding claim 20, Florin discloses the use of a modem (column 10, lines 21-25).

Regarding claims 21-22 see claims 9-10.

Regarding claim 23, Florin discloses in figures 1 and 2 a transceiver 54 for use with a television program delivery system with menu selection of programs (figure 12), the set top terminal having a microprocessor 63 and microprocessor instructions for prompting generation of menus (column 9, line 59-column 10, line 6), comprising:

An interface 82 to the STB for communicating data and video signals between the STB and a disc storage device (column 10, lines 7-19, a CD ROM module may playback multimedia CD ROM titles, photo CDs and motion picture CDs), A disc storage device 70 (or optional hard drive, column 10, lines 7-26) connected to the interface providing local storage capacity,

And a microprocessor 63 connected between the interface and the disc storage device (figure 2).

Florin discloses the use of a number of plug in devices such as hard discs, modems, and CD-ROMs (column 10, lines 7-26), but is silent regarding the use of a hardware upgrade and a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Granger discloses in figure 6, an upgrade module 300 for a set top box 302 which enables a user to operate more than two channels simultaneously (column 7, lines 11-41) thus enabling a user to expand the capabilities of a STB in the future.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Florin to utilize a hardware upgrade as taught by Granger thus enabling a user to expand the capabilities of a STB in the future.

The combination of Florin and Granger is silent regarding the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Graczyk discloses in figures 44-49, the use of a number of upgrade cards, including an audio upgrade card 510, which utilizes a microprocessor 33 (figure 28), which communicates with the CPU of the personal computer via interface 300, and includes an upgrade of an external CDROM, the personal computer includes STB functionality via the use of an onboard TV tuner (column 21, lines 19-59, column 22, lines 7-51, column 32, line 67-column 33, line 20, , lines 31-52, column 34, lines 3-6, 50-56), thus reducing the CPU load of the primary processor by utilizing an upgrade

processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin and Granger to use a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface as taught by Graczyk, thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Regarding claims 24 and 27, Florin discloses that the TV program delivery system may be satellite or cable (column 8, lines 3-17).

Regarding claims 25-26, Florin discloses in figure 1, a service provider 50, which delivers programming to a user device (column 8, lines 7-12).

Regarding claim 28, see claim 15.

Regarding claims 29-30, see claims 9-10.

Regarding claim 31, Florin discloses in figures 1 and 2 a transceiver 54 for use with a television program delivery system with menu selection of programs (figure 12),

the set top terminal having a microprocessor 63 and microprocessor instructions for prompting generation of menus (column 9, line 59-column 10, line 6), comprising:

An interface 82 to the STB for communicating data and video signals between the STB and a disc storage device (column 10, lines 7-19, a CD ROM module may playback multimedia CD ROM titles, photo CDs and motion picture CDs),

A disc storage device 70 (or optional hard drive, column 10, lines 7-26) connected to the interface providing local storage capacity,

a microprocessor 63 connected between the interface and the disc storage device (figure 2)

an output 69 connected to the receiver and the storage device wherein the output accepts TV program signals from the receiver and data signals from the storage device.

Florin discloses the use of a number of plug in devices such as hard discs, modems, and CD-ROMs (column 10, lines 7-26), but is silent regarding the use of a hardware upgrade and the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Granger discloses in figure 6, an upgrade module 300 for a set top box 302 which enables a user to operate more than two channels simultaneously (column 7, lines 11-41) thus enabling a user to expand the capabilities of a STB in the future.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Florin to utilize a hardware upgrade as taught by Granger thus enabling a user to expand the capabilities of a STB in the future.

The combination of Florin and Granger is silent regarding the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Graczyk discloses in figures 44-49, the use of a number of upgrade cards, including an audio upgrade card 510, which utilizes a microprocessor 33 (figure 28), which communicates with the CPU of the personal computer via interface 300, and includes an upgrade of an external CDROM, the personal computer includes STB functionality via the use of an onboard TV tuner (column 21, lines 19-59, column 22, lines 7-51, column 32, line 67-column 33, line 20, , lines 31-52, column 34, lines 3-6, 50-56), thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin and Granger to use a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface as taught by Graczyk, thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Regarding claims 32-33, Florin discloses in figure 2, that output 69, may be coupled to a TV 58 out connect to an AV device 57 (column 9, lines 4-10).

Regarding claim 34, see claim 2.

Regarding claim 35, Florin discloses that CPU 63 is connected to CDROM 70 via system bus 64 in figure 2.

Regarding claim 36 see claim 4.

Regarding claim 38, see claim 15.

Regarding claims 39-40 see claims 9-10.

Regarding claim 41, Florin discloses a method for delivering TV programs through a TV program delivery system (figure 1) with menu selection of programs (figure 12, column 9, line 59-column 10, line 6) comprising:

Receiving a TV program from a headend 50 (column 8, lines 8-12),

Communicating data and video signals (column 10, lines 7-19, a CD ROM module may playback multimedia CD ROM titles, photo CDs and motion picture CDs), interface 82 within the STB (column 8, lines 40-44), the set top terminal having a microprocessor 63 and microprocessor instructions for prompting generation of menus (column 9, line 59-column 10, line 6)

Providing TV program signals to the STB based on the subscriber input (column 11, lines 36-59);

Accessing data via disc storage device 70 (or optional hard drive, column 10, lines 7-26) connected to the interface providing local storage capacity

Displaying the TV program or information based on the accessed data (column 9, lines 4-10).

Florin inherently includes a microprocessor coupled to the CDROM or hard disc as a microprocessor is required to interface and control the media.

Florin discloses the use of a number of plug in devices such as hard discs, modems, and CD-ROMs (column 10, lines 7-26), but is silent regarding the use of a hardware upgrade the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Granger discloses in figure 6, an upgrade module 300 for a set top box 302 which enables a user to operate more than two channels simultaneously (column 7, lines 11-41) thus enabling a user to expand the capabilities of a STB in the future.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Florin to utilize a hardware upgrade as taught by Granger thus enabling a user to expand the capabilities of a STB in the future.

The combination of Florin and Granger is silent regarding the use of a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface.

Graczyk discloses in figures 44-49, the use of a number of upgrade cards, including an audio upgrade card 510, which utilizes a microprocessor 33 (figure 28), which communicates with the CPU of the personal computer via interface 300, and

includes an upgrade of an external CDROM, the personal computer includes STB functionality via the use of an onboard TV tuner (column 21, lines 19-59, column 22, lines 7-51, column 32, line 67-column 33, line 20, , lines 31-52, column 34, lines 3-6, 50-56), thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin and Granger to use a microprocessor capable of communications with the microprocessor of the set top terminal through the upgrade interface as taught by Graczyk, thus reducing the CPU load of the primary processor by utilizing an upgrade processor to handle the sound generation and enable the connection of a wide variety of computer peripherals.

Regarding claim 42, see claim 9.

Regarding claim 43, see claim 4.

Regarding claim 44, see claim 2.

Regarding claims 47-48, Florin discloses that information concerning the programs is retrieved in the VBI (column 9, lines 13-16, figure 3b, column 10, lines 45-67, column 14, line 59-column 15, line 7).

Regarding claims 49-50, Florin discloses that a user input is received via a remote control 60 (column 8, lines 40-44).

Regarding claim 51, Florin discloses generating a menu on a television (figure 12) and receiving menu selections via subscriber input (column 15, lines 12-37).

Regarding claim 52, Florin discloses that once a user presses the select button 155 over a time slot the program is displayed (column 15, lines 34-36).

Regarding claims 53-54, see claims 9-10.

Regarding claim 55, see claim 13.

4. Claims 5, 37, 45, 46 and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin in view of U.S. Patent 5,483,277 to Granger and U.S. Patent 5,192,999 to Graczyk in further view of U.S. Patent 5,638,426 to Lewis and U.S. Patent 5,247,575 to Sprague.

Regarding claims 5, 37, 45, 46 and 56-57, Florin discloses a receiver 54, which interfaces with a CDROM 70 and receives programming from a provider 50 (figures 1 and 2) and information via the VBI.

The combination of Florin, Granger and Graczyk fails to disclose receiving information concerning programs, monitoring the information and accessing information via a disc storage device in response to monitoring.

Lewis discloses a multimedia processing system in which a TV program is synchronized to supplemental data on a remote CD/I via a cable or broadcast feed, a user can then access the related information in more detail (column 15, lines 21-29, 43-56).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin, Granger and Graczyk to utilize the supplemental data as taught by Lewis, thus enabling a user to learn more about a subject in greater detail.

The combination of Florin, Granger, Graczyk and Lewis fails to disclose accessing a local disc device.

Sprague discloses a computing device with a local CDROM, a user may search keywords and upon receiving authorization information, the CDROM is accessed locally (column 16, lines 39-58, column 17, lines 10-22, column 19, lines 1-4, column 20, lines 5-29) thus providing faster access times.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin Granger, Graczyk and Lewis to utilize the local CDROM access of Sprague in order to provide faster access times to requested data.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin in view of U.S. Patent 5,483,277 to Granger and U.S. Patent 5,192,999 to Graczyk in further view of U.S. Patent 5,432,542 to Thilbadeau.

Regarding claim 15, the combination of Florin, Granger, and Graczyk discloses a STB.

The combination of Florin, Granger, and Graczyk fails to disclose the use of an HDTV terminal.

Thilbadeau discloses the use of an HDTV terminal (column 5, lines 32-45) thus enabling a viewer to watch a program in more detail.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin, Granger and Graczyk to utilize an HDTV terminal, as taught by Thilbadeau in order to provide a higher quality picture thus enabling a viewer to watch a program in more detail.

6. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin in view of U.S. Patent 5,483,277 to Granger and U.S. Patent 5,192,999 to Graczyk in further view of U.S. Patent 4,920,339 to Friend.

Regarding claims 17-18, Florin discloses that a SCSI interface may be utilized for accessing digital storage devices such as hard disks (column 10, lines 21-23).

The combination of Florin, Granger, and Graczyk does not disclose if more than one hardware upgrade is connected together in a daisy chain arrangement.

Friend discloses the use of a SCSI daisy chain system in a personal computer which allows for connections between a number of hardware upgrades such as printers, disc drives, compact disk readers or other computers, and allows for each device to have an address and allows neighboring devices to find out the addresses of other

Art Unit: 2623

devices via an interrogation protocol (column 1, line 65-column 2, line 11, line 61-column 3, line 16).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Florin, Granger, and Graczyk to utilize a SCSI daisy chain as taught by Friend, thus allowing a number of computer upgrades to be connected to a computer via a single port, and allowing easy recognition of the addresses on other devices within the daisy chain via the use of an interrogation protocol.

(10) Response to Argument

Arguments with regards to the rejection of claims 1, 11, 23, 31, and 41 under U.S.C. 112 Paragraph 1.

Appellant argues that the 35 U.S.C. 112 first paragraph rejection should be withdrawn (pages 12-13).

The Examiner has withdrawn the 35 U.S.C. 112 First paragraph rejection and notes that the independent claims are fully supported by the current application's specification (filed 9/15/99). The Examiner recognizes that the 112 1st Paragraph written description requirement does not appear appropriate for questioning date priority benefits.

Arguments with regards to claims 1, 2, 3, 4, 6-13, 16-36, 38-44 and 47-55.

Appellant argues that the limitations of the claims are fully supported by the disclosure of the 07/991,074 parent application. Appellant shows support for each limitation and argues that neither the Florin nor Granger Reference are prior art against claim 1 because these references have priority dates after the priority date of Appellants independent claims and the rejection becomes a 35 USC 103(a) rejection over Graczyk. (Pages 12-15)

Appellant further argued with regards to the 112 rejection that a simple decompression box is a simpler version of the set top terminal as indicated by name and described in the spec and that some of the features are similar to the set top terminal (for example upgrade port 662, and thus one skilled in the art would recognize that the features of the simple decompression box are applicable to similar features found on the set top terminal. (page 13)

As a preliminary matter, the Examiner notes that the independent claims are fully supported in the present application, however Appellant has not provided evidence for support of the dependent claims having priority to the priority document 07/991,074. Further the Examiner notes that Appellant is correct that the present application is a divisional of US 5,990,927 which is a CIP of priority document 07/991,074. Additionally,

Appellant has not mapped out support for each limitation in the present application, in that the present application utilizes entirely different figures. For example, the corresponding figures 12 a/b are not even disclosed in the 07/991,074 application.

The Examiner notes that Appellant's specification uses two entirely different terms, simple decompression box, and set top terminal shown in two entirely different figures, and in no way states that the functionality is usable together. Further the claims require an interface between a set top terminal and not a simple decompression box. While page 57 of appellants specification states that the simple decompression box may not have the full functionality of the set top terminal, it fails to specifically teach which functions are missing, and how to integrate those connections, particularly where the connections from upgrade module 700 shown in figure 9a would be integrated with upgrade port 662 in figure 8b in the diagram shown for the set top terminal 220 in figure 7b. Figure 7b does not disclose where that input would be received; there is a text/video combiner 624, text generator 621, and a video/text demux 616 but there is no input port (or interface as required by the claim) for an upgrade port 662. These respective devices have their own respective separate one-way connections to a video compressor 618 (with demux 616 having a separate connection to Text generator 621 which is in turn connected to text combiner 624), and do not show a common pathway for any data between a hardware upgrade and a set top terminal via an interface.

As appellant has indicated that interface 662 is the interface to the set top terminal for communicating data and video signals between the set top terminal and

Art Unit: 2623

hardware upgrade, it would not be apparent to one of ordinary skill in the art how to make those connections in order to transmit the audio and video data, nor is it clear to one of ordinary skill in the art that appellants invention is fully enabled in the disclosure of the 07/991,074 priority document. Thus it is not apparent to one of ordinary skill in the art, Appellant at the time of filling of the application, possessed the claimed invention in the priority document 07/991,074 and the instant application may be afforded, at best, the priority date of parent application US 5,990,927, filed 12/2/1993; with both Florin and Granger considered as valid prior art as their respective priority dates are prior to that date. Therefore, the combination of Florin and Granger, with Graczyk teaches each and every element of the independent claims.

Arguments with regards to claims 5,37,45, 46 and 56-57.

Appellant argues that Florin and Granger are not prior art and that Sprague, in combination with Graczyk does not teach appellants invention (page 16).

As discussed in the previous section, Florin and Granger are valid prior art, and thus, in combination with Graczyk and Sprague teach each and every element of claims 5, 46, 45, 46 and 56-57.

Arguments with regards to claim 15.

Appellant argues that Florin and Granger are not prior art and that Thilbadeau, in combination with Graczyk does not teach appellants invention (pages 16-17).

As discussed in the previous sections, Florin and Granger are valid prior art, and thus, in combination with Graczyk and Thilbadeau teach each and every element of claim 15.

Arguments with regards to claims 17-18.

Appellant argues that Florin and Granger are not prior art and that Friend, in combination with Graczyk does not teach appellants invention (pages 18-18).

As discussed in the previous sections, Florin and Granger are valid prior art, and thus, in combination Graczyk and Friend teach each and every element of claims 17-18.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Hunter B. Lonsberry

Primary Examiner


Art Unit 2623

Conferees:

Scott Beliveau


SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER
Acting SPE 2623

Andrew Koenig


ANDREW Y. KOENIG
PRIMARY PATENT EXAMINER
Acting SPE - AU2623